

REMARKS

The Official Action mailed February 22, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on December 22, 2004, and September 9, 2005.

Claims 1-14 were pending in the present application prior to the above amendment. Claims 1-14 have been canceled without prejudice or disclaimer, and new claims 15-23 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 15-23 are now pending in the present application, of which claims 15-18 and 23 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 7 of the Official Action rejects claims 1 and 2 under 35 U.S.C. § 112, second paragraph, asserting that the phrase "to/from" renders the claims indefinite. In response, claims 1-14 have been canceled without prejudice or disclaimer, and new claims 15-23 have been added to recite additional protection to which the Applicant is entitled. Claims 15-23 do not recite "to/from." The Applicant respectfully submits that new claims 15-23 are definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

Paragraph 9 of the Official Action rejects claims 1-3 as anticipated by U.S. Patent No. 5,870,588 to Rompaey. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a

single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Claims 1-14 have been canceled without prejudice or disclaimer, and new claims 15-23 have been added to recite additional protection to which the Applicant is entitled. Independent claim 15, for example, recites an information processing apparatus comprising a plurality of hardware circuit blocks, each configured so as to implement one of functional units of certain information processing software as hardware, the plurality of hardware circuit blocks mutually operating in pipeline, each of the plurality of hardware circuit blocks comprising: a first processing circuit module connected to a memory for operating to selectively make read access or write access to the memory in response to the input of packet data and on the basis of the content of the packet; a second processing circuit module for operating to receive packet data outputted from the first processing module to create packet data obtained by subjecting a predetermined information process to the received packet; and an interface module for operating to receive input packet data to each hardware circuit block and the packet data created by the second processing circuit module to provide these received packet data to the first processing circuit module at separate timing, wherein the first processing circuit module responds to either one of the input packet data provided via the interface circuit module and the packet data subjected to the predetermined information process so that when responding to the input packet data the first processing circuit module reads out of the memory information data needed to process the input packet data and when responding to the packet data subjected to the predetermined information process the first processing circuit module writes new information data associated with that packet data into the memory while causing each hardware circuit block to output the packet data subjected to the predetermined information process. The Applicant respectfully submits

that Rompaey does not teach the above-referenced features of the present invention or the features of claims 15-23 of the present invention, either explicitly or inherently.

Since Rompaey does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 11 of the Official Action rejects claims 7-14 as obvious based on the combination of Rompaey and U.S. Patent No. 6,021,266 to Kay. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Rompaey. Kay does not cure the deficiencies in Rompaey. The Official Action relies on Kay to allegedly teach the features of the claims 7-14. In response, claims 1-14 have

been canceled without prejudice or disclaimer, and new claims 15-23 have been added to recite additional protection to which the Applicant is entitled. Rompaey and Kay, either alone or in combination, do not teach or suggest the features of claims 15-23 or that Rompaey should be modified to include any of the features of claims 15-23. Since Rompaey and Kay do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New claims 15-23 have been added to recite additional protection to which the Applicant is entitled. For the reasons stated above, the Applicant respectfully submits that new claims 15-23 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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